



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

10/568,737

01/03/2007

Stephane Rioux

484112.436USPC

4671

500 7590 03/10/2008

SEED INTELLECTUAL PROPERTY LAW GROUP PLLC
701 FIFTH AVE
SUITE 5400
SEATTLE, WA 98104

EXAMINER

BASKAR, PADMAVATHI

ART UNIT

PAPER NUMBER

1645

MAIL DATE

DELIVERY MODE

03/10/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Election/Restrictions

1. Applicants amendment filed on 2/25/06 is entered.

Claims 1, 5, 10, 14-17, 21, 23-26, 30-33, 36 and 37 are pending in the application.

2. Restriction to one of the following groups of invention is required under 35 U.S.C. 121:

I. Claims 1, 5, 10, 14, 15 and 16 drawn DNA, vector, host cell and a process for expressing the polypeptide classified in class 536, subclass 23.7.

Further restriction to SEQ.ID.NO required (see paragraph # 4).

II. Claims 17, 21, 23, 24, 36 and 37 drawn to a polypeptide , chimeric polypeptide , pharmaceutical composition and kit comprising said polypeptide or chimeric polypeptide protein, composition, vaccine classified in class 530, subclass 350.

Further restriction to one SEQ.ID.NO required (see paragraph # 4).

III. Claims 25, 26 and 30 drawn to a method for prophylactic or therapeutic treatment of *S. pyogenes* infection in a host polypeptide classified in class 424, subclass 184.1

Further restriction to one SEQ.ID.NO required (see paragraph # 4).

IV. Claim 31 drawn to method for prophylactic or therapeutic treatment of infections in a host, including pharyngitis, erysipelas, impetigo, scarlet fever, and invasive diseases such as bacteremia and necrotizing fasciitis classified in class 424, subclass 190.1.

Further restriction to one SEQ.ID.NO required (see paragraph # 4).

V. Claims 32 and 33 drawn to a method of detecting the presence of *S. pyogenes* infection classified in class 435, subclass 7.1.

Further restriction to one SEQ.ID.NO required (see paragraph # 4).

Art Unit: 1645

3. The inventions are distinct, each from the other because of the following reasons: Group I is directed to DNA, which consists of nucleic acids, and Invention II is drawn polypeptides which is distinct from Invention I since polypeptides are made of amino acids. These products are different to each other structurally, biochemically and functionally and are drawn to patentably distinct inventions which have materially different physical and chemical properties and structures as represented by their divergent sequences.

Groups III, IV and V are patentably distinct methods using patentably distinct and different biological reagents, different method steps that result in different outcome.

Distinct Inventions

4. For each group of inventions I - VIII above, restriction to one of the following SEQ.ID.NO is also required under 35 USC 121. Therefore, election is required of one of inventions I – V and one of SEQ ID NO: 2, 4, 6, 22, 24, 26, 28, 30, 32, 34, 36, 38, 40, 42 or 44 polypeptide or polynucleotide encoding said polypeptide. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions; represent structurally different polypeptides and the polynucleotides encoding them. Therefore, where structural identity is required, such as for hybridization or expression, the different sequences have different effects. Thus, each sequence is unique and patentably distinct since each sequence has a different structure with specific polypeptide or nucleic acid encoding polypeptide and is identified by a specific SEQ.ID.NO. Restriction is deemed proper because these products appear to constitute patentably distinct inventions. These sequences are thus deemed to constitute independent and distinct inventions within the meaning of 35 U.S.C. 121. Absent evidence to the contrary, each such sequence is presumed to represent an independent and distinct invention, subject to restriction requirement pursuant to 35 U.S.C. 121 and 37 CFR 1.141.

5. Invention II is related to inventions III/IV/V as product and process of use. The inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case the protein of Group II can be used in immunoaffinity chromatography methods for purifying antibodies and need not be used in the inventions III/IV/V

Art Unit: 1645

6. Because these inventions are distinct for the reasons given above, have acquired a separate status in the art as shown by their different classification, the literature and sequence searches required for each of the Groups are not required for another of the Groups, restriction for examination purposes as indicated is proper.

7. The examiner has required restriction between product and process claims. Where applicant elects claims directed to the product, and a product claim is subsequently found allowable, withdrawn process claims that depend from or otherwise include all the limitations of the allowable product claim will be rejoined in accordance with the provisions of MPEP 821 .04.

Process claims that depend from or otherwise include all the limitations of the patentable product will be entered as a matter of right if the amendment is presented prior to final rejection or allowance, whichever is earlier. Amendments submitted after final rejection are governed by 37 CFR 1 .1 16., amendments submitted after allowance are governed by 37 CFR 1 .312.

In the event of rejoinder, the requirement for restriction between the product claims and the rejoined process claims will be withdrawn, and the rejoined process claims will be fully examined for patentability in accordance with 37 CFR 1.104. Thus, to be allowable, the rejoined claims must meet all criteria for patentability including the requirements of 35 U.S.C. 101 , 102, 103, and 1 12. Until an elected product claim is found allowable, an otherwise proper restriction requirement between product claims and process claims may be maintained. Withdrawn process claims that are not commensurate in scope with an allowed product claim will not be rejoined. See "Guidance on Treatment of Product and Process Claims in light of In re Ochiai, In re Brouwer and 35 U.S.C 103(b)," 1184 O.G. 86 (March 26, 1996). Additionally, in order to retain the right to rejoinder in accordance with the above policy, Applicant is advised that the process claims should be amended during prosecution either to maintain dependency on the product claims or to otherwise include the limitations of the product claims. Failure to do so may result in a loss of the right to rejoinder.

Further, note that the prohibition against double patenting rejections of 35 U.S.C.121 does not apply where the restriction requirement is withdrawn by the examiner before the patent issues. See MPEP 804.01.

8. Should applicant traverse on the ground that the inventions are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the inventions to be obvious variants or clearly admit on the record that this is the case. In either

Art Unit: 1645

instance, if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a rejection under 35 U.S.C. 103(a) of the other invention.

9. Concerning the burden of search, classification of subject matter is merely one indication of the burdensome nature of the search involved. The DNA database searches required by each of the sequences and the literature searches for each of the sequences, both of which are particularly relevant in this art, are not co-extensive and are much more important in evaluating the burden of search. Further, it is doubted that applicants would readily accept the rejection of one sequence by the application of art teaching another sequence. Clearly different searches and issues are involved in the examination of each group.

10. Applicant is advised that the response to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

11. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Conclusion

12. Papers related to this application may be submitted to Group 1600, AU 1645 by facsimile transmission. Papers should be transmitted via the PTO Fax Center, which receives transmissions 24 hours a day and 7 days a week. The transmission of such papers by facsimile must conform to the notice published in the Official Gazette, 1096 OG 30, November 15, 1989. The Right Fax number is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PMR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PMR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PMR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you

Art Unit: 1645

would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Padma Baskar Ph.D., whose telephone number is ((571) 272-0853. A message may be left on the Examiner's voice mail system. The Examiner can normally be reached on Monday to Friday from 6.30 a.m. to 4.00 p.m. except First Friday of each bi-week.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Shanon Foley can be reached on (571) 272-0898.

Respectfully,

/Padma Baskar/

Art Unit 1645